

REMARKS

Reconsideration and entry of the following remarks are respectfully requested. Claims 1-15 remain pending.

Claims 1-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over McMillen (US 4296343) in view of Yamaguchi et al. This rejection is respectfully traversed.

With regard to the Examiner's response to Applicants' previous arguments, the Examiner contends that, "...the features upon which the applicant relies (i.e., that the S-shaped structure not require a planar portion) are not recited in the claim(s)". Applicants respectfully disagree since the Amendment dated December 13, 2005 (entered via the RCE dated February 23, 2006) recites,

wherein, in section, the at least one raised portion is joined directly with a surface defining the at least one recess by a generally S-shaped structure thereby defining an entirely curved and non-planar transition there-between.

The Examiner concedes that McMillen does not teach the "generally S-shaped structure defining an entirely curved and non-planar transition". The Examiner cites Yamaguchi as teaching a raised portion (d) joined directly with a surface defining a recess by a "generally S-structure thereby defining an entirely curved and non-planar transition there-between". The Examiner contends that it would have been obvious "to modify the S-shaped structure of McMillen in view the S-shaped structure as taught by Yamaguchi because it provides a means for holding magnets in a case without requiring any binding agent, springs or screws".

The Examiner admits that "McMillen is silent as to the quality of the magnet holding means" yet the Examiner's position is that one of ordinary skill in the art would modify McMillen with the structure of Yamaguchi since the structure of Yamaguchi provides "the added benefit of being able to be implemented without requiring any binding agent, springs or screws". McMillen discloses that magnets 50 and 52 "are secured within the interior of the curved housing portions" (column 3, lines 32-34). This

teaching of McMillen does not preclude a magnet connection than is achieved by a method other than “binding agents, springs or screws”. The Examiner’s sole reasoning for making the Yamaguchi modification of McMillen is to secure the magnets of McMillen without binding agents, springs or screws.

The Examiner is reminded that an obviousness rejection requires a specific showing as to why one of ordinary skill in the art would have selected the components for combination in the manner claimed.¹ “The examiner’s conclusory statements ... do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and [cannot] be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to ‘[use] that which the inventor taught against its teacher.’” *In re Lee*, 61 USPQ2d at 1434 (*quoting W.L. Gore v. Garlock, Inc.*, 202 USPQ 303, 312-13 (Fed. Cir. 1983)).

As noted in the previous response, the “S-shaped” structure of McMillen requires the planar portions since they are part of the flat sidewalls 46 and 48, from which raised portions 54 and 56 are formed. See also FIG. 8b of McMillen wherein planar portions join items 85 and 80. McMillen teaches at column 3, lines 28-31 “a pair of generally parallel flat sidewalls 46 and 48, preferably fabricated by flattening sidewalls of a section of tubing, such as round tubing. The housing 12 could also be constructed from a flat sheet of ferrous material.”

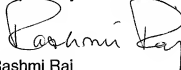
Modifying McMillen so that sidewall 46 and 48 are continuously curved and non-planar as suggested by the Examiner would destroy the invention of McMillen and would therefore be improper. See Ex parte Hartman, 186 U.S.P.Q. 336, 337 (P.T.O.B.O.A. 1974) (reversing rejection when modification would destroy basis for invention in one or two references).

¹*Cf. In re Lee*, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (*quoting In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”); *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998) (“the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” (emphasis added))).

There is simply no suggestion or motivation to modify McMillen in the manner suggested by the Examiner. Furthermore, even if the modification was made, the modification would be improper since it would destroy the invention of McMillen. Therefore, the rejection of claims 1, 6 and 10 and the claims that depend there-from is improper and should be withdrawn.

All objections and rejections having been addressed, it is respectfully submitted that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Rashmi Raj", written over the typed name.

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